I. Status of the Claims

Claims 1-16 are pending in the application. Claims 1-11 have been examined. Claims 12-16 have been withdrawn.

Claims 1-11 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite.

Claims 1-11 stand rejected under 35 U.S.C. §112, first paragraph, as not enabled.

Claims 1-11 stand rejected under the doctrine of obviousness-type double patenting over claims 1-6 and 9-12 of U.S. Patent No. 6,469,042.

Claim 17 has been added. Support for new claim 17 is found in the claims as originally filed, notably in claims 2 and 4 and in the Specification, for example on page 15, lines 10-13.

II. Response to the Restriction Requirement

The Patent Office withdrew claims 12-16 from consideration as drawn to non-elected inventions. Applicants have canceled claims 12-16. Applicants hereby reserve the right to file one or more subsequent applications directed to the subject matter of claims 12-16.

III. Response to Objection to Claims 1-11

The Patent Office objected to claims 1-11 as containing non-elected subject matter. The Patent Office asserts claims 1 and 2 contain compounds drawn to the non-elected subject matter.

Applicants have amended claims 1 and 2 to recite compounds of Formula I, corresponding to the elected Group. Applicants submit that this amendment to claims 1 and 2, coupled with the cancellation of claims 3 and 11 and the amendments to claim 4 overcome the Patent Office's objection to claims 1-11.

IV. Response to the Objection to the Title

The Patent Office contends the title of the application is not descriptive after the Restriction Requirement. The Patent Office suggests adding the term "3-fluoro-2-oxindole" to the beginning of the title.

Applicants have amended the title as suggested by the Patent Office.

V. Response to the Rejection of Claims 1-11 Under 35 U.S.C. §112, Second Paragraph

The Patent Office rejected claims 1-11 under 35 U.S.C. §112, second paragraph, as indefinite. The Patent Office asserts the phrase appearing on line 7, page 14 of the Specification is confusing. The Patent Office asks, "When Y is oxygen, is R5 never alkyl, substituted or not? Or are

fluoroalkoxy and chloroalkoxy permitted but non-substituted alkoxy groups not permitted for radical YR5?" Office Action, page 3. Applicants traverse the rejection and submit the following comments.

The Court of Appeals for the Federal Circuit stated "the standard for assessing whether a patent claim is sufficiently definite to satisfy the statutory requirement [is] as follows: If one skilled in the art would understand the bounds of the claim when read in light of the specification, then the claim satisfies section 112 paragraph 2." Exxon Research and Engineering Co. v. U.S., 265 F.3d 1371, 1375 (Fed. Cir. 2001) citing Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 875 (Fed. Cir. 1993). Applicants respectfully submit one of ordinary skill in the art would readily understand the language identified by the Patent Office, and would be apprised of the metes and bounds of the claims as written. However, in an effort to advance prosecution, applicants clarify that it is intended that R^5 is not unsubstituted alkyl when Y is O.

In view of the above clarification, applicants submit that claims 1-11 are in compliance with 35 U.S.C. §112, second paragraph. Accordingly, applicants respectfully request that the rejection of claims 1-11 under with 35 U.S.C. §112, second paragraph, be reconsidered and withdrawn.

VI. Response to the Rejection of Claims 1-11 Under 35 U.S.C. §112, First Paragraph

The Patent Office rejected claims 1-11 because the Patent Office contends the specification "does not reasonably provide enablement for solvates and hydrates of the claimed compounds." Office Action, page 4. Applicants traverse the rejection and submit the following comments.

Applicants respectfully submit that the amendments to claims 1 and 2 overcome this rejection of the claims under 35 U.S.C. §112, first paragraph. Accordingly, applicants respectfully request that the rejection of the claims be reconsidered and withdrawn.

VII. Response to the Double Patenting Rejection

The Patent Office rejected claims 1-11 under the doctrine of obviousness-type double patenting over claims 1-6 and 9-12 of issued US Patent No. 6,469,042. The Patent Office asserts that the "elected subject matter is identical in scope to that claimed in the first claim of the reference, with the exception of the presently taught salts, solvates, etc." Office Action, page 8. The Patent Office further contends the cited reference discloses "KNCQ diseases are associated with various migraine conditions." Office Action, page 8.

Applicants submit herewith a terminal disclaimer filed pursuant to 37 C.F.R. §1.321(c) signed by an attorney of record. Applicants submit that this terminal disclaimer obviates the double patenting rejection.

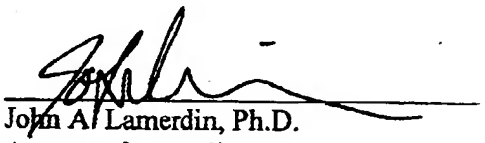
VIII. Conclusions

In consideration of the above amendments and remarks, applicants respectfully request that the objections and rejections of record be withdrawn. Applicants further submit the subject patent application is in condition for allowance and courteously solicit a Notice of Allowance.

If any small matter should remain outstanding after the Patent Office has had an opportunity to review the instant paper, the Patent Office is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Office Action.

Although it is believed no additional fee is due, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment associated with the filing of this correspondence to Deposit Account Number 19-3880. Furthermore, if any extension of time not already accounted for is required, such extension is hereby petitioned for, and it is requested that any fee due for said extension be charged to Deposit Account Number 19-3880.

Respectfully submitted,



John A. Lamerdin, Ph.D.
Attorney for Applicants
Reg. No. 44,858

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
(609) 252-3575

Date: February 9, 2004